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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/660,075 | 09/10/2003 | Ryan W. Cuddy | 112300-1679 | 6174 |

29159 7590 09/26/2007

BELL, BOYD & LLOYD LLP
P.O. Box 1135
CHICAGO, IL 60690

| EXAMINER | |
|---|---|
| MCCULLOCH JR, WILLIAM H | |
| **ART UNIT** | **PAPER NUMBER** |
| 3714 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 09/26/2007 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/660,075 | CUDDY ET AL. | |
| | Examiner | Art Unit | |
| | William H. McCulloch Jr. | 3714 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-70* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-70* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date: 9/5/2004, 2/21/2006, 4/28/2006, 3/28/2007.

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statements (IDS) with mailroom dates 9/5/2004, 2/21/2006, 4/28/2006, and 3/28/2007 were filed in compliance with the provisions of 37 CFR 1.97-1.98. Accordingly, the examiner has considered the information disclosure statements.

### *Oath/Declaration*

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The declaration submitted 1/12/2004 is defective because it identifies a priority claim to application number 10/288,**752** on page two of the document. The application number is incorrect. Applicant may have intended to claim priority to application number 10/288,**750**. Appropriate correction is required.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-70 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,808,454. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed toward substantially similar subject matter.

5. Claims 1-70 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,494,785. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed toward substantially similar subject matter and/or because the differences between the claims would have been obvious to one of ordinary skill in the art at the time of invention (see 35 USC § 103 rejection below).

6. Claims 1-70 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 6,786,820. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed toward substantially similar subject matter.

7. Claims 1-70 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,971,953. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed toward substantially similar subject matter.

### *Claim Rejections - 35 USC § 101*

8. Claim 30 is rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Claim 29, from which claim 30 depends, recites a plurality of locations including a plurality of locations which form a path between a first location and a second location, and additionally recites terminating movement of the symbol if the symbol moves to one of the locations that is not between the first location and the second location. Claim 30 recites that each of said plurality of locations are between said first location and said second location. The limitation recited by claim 30 renders the invention inoperable because the gaming device would essentially enter an endless loop if each location were between the first and second locations because the requirement for termination is that the symbol moves to a location that is not between the first and second locations. A similar situation exists for claim 41 (which depends from claim 38). Appropriate correction is required. For the purposes of this action, the Examiner will interpret claims 30 and 41 as reciting that each of said plurality of locations are on or between said first location and said second location. This rejection is related to a rejection under 35 U.S.C. § 112, which is also contained in this action. Applicant is encouraged to consider and address the § 101 and § 112 rejections concurrently.

### *Claim Rejections - 35 USC § 112*

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 29, 34, 38, and 45 (and claims depending therefrom) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 29 recites, "a plurality of locations including a plurality of locations which form a path between said first location and said second location". Similarly, claims 34, 38, and 45 recite, "a plurality of locations, wherein a plurality of said locations form a path". These recitations claim two separate pluralities of locations, which are not distinguishable from one another. Thus, the claims are indefinite because they fail to particularly point out and distinctly claim the subject matter of the invention. Furthermore, references to "the plurality of locations" or "said plurality of locations" lack sufficient antecedent basis because it is ambiguous as to which plurality of locations they are referring. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-52, 55-56, 59-60, 63-64, and 67-68 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 6,767,283 to Weiss (hereinafter Weiss).

Regarding claims 1-28, 51-52, 55-56, and 59-60 Weiss teaches a gaming device and method comprising the following limitations:

- A primary game operable upon a wager by a player (see at least 3:10-67);
- A plurality of locations, which includes a first location, wherein the plurality of said locations form a path (see at least figs. 1 and 3-5, and descriptions thereof);
- A plurality of awards associated with a plurality of said locations along the path (see e.g., elements 41 in fig. 4);
- At least one symbol adapted to make a plurality of moves to a plurality of the locations (see e.g., element 35 in fig. 4);
- At least one setback condition associated with at least one of the locations along the path (see e.g., elements 43 in fig. 4);
- At least one advance condition associated with at least one of said locations along the path (see e.g., elements 41 and 46 in fig. 4);
- A display device operable to display said symbol and the locations (e.g., element 2 in figs. 2-5);
- A processor operable with the display device to control the gaming device (e.g., processor "P" in 3:31-33);
- A processor operable to provide the player at least one award based on the number of different locations the symbol is moved to (see at least 4:1-28);
- A triggering event associated with said game (see at least 3:59-67), wherein after the occurrence of said triggering event the symbol is moved to at least

one location along the path toward the first location (see at least 4:1-28), the symbol is relocated to one of the locations along the path further from the first location if the symbol moves to the location associated with the setback condition (see at least 4:16-19), the symbol movement terminates if the symbol is moved to the first location, and the player is provided a total award based on any award associated with any of the locations the symbol is moved to and the number of locations the symbol is moved to before the symbol moves to the first location (see at least 1:65-2:14 and 4:29-58).

Regarding claims 29-50, 63-64, and 67-68, Weiss teaches a gaming device comprising the following limitations in addition to those listed above:

- A primary game operable upon a wager by a player (see at least 3:10-67);
- A first location (see e.g., "HOME" location or any of elements 41 in fig. 4);
- A second location (see e.g., elements 46 or 52, and/or elements 41 occurring after a first location);
- A plurality of locations, wherein a plurality of said locations form a path between said first location and said second location (see at least figs. 1 and 3-5, and descriptions thereof);
- A plurality of awards associated with a plurality of said locations along the path (see e.g., elements 41 in fig. 4);
- At least one symbol adapted to make a plurality of moves to a plurality of the locations (see e.g., element 35 in fig. 4);

- At least one setback condition associated with at least one location along the path (see e.g., elements 43 in fig. 4);
- At least one advance condition associated with at least one of said locations along the path (see e.g., elements 41 and 46 in fig. 4);
- A display device operable to display said symbol and the locations (see e.g., element 2 in figs. 2-5);
- A processor operable with the display device to control the gaming device (e.g., processor "P" in 3:31-33);
- A processor operable to provide the player at least one award based on the number of different locations the symbol is moved to (see at least 4:1-28);
- A triggering event associated with said primary game (see at least 3:59-67), wherein after the occurrence of said triggering event the symbol is moved along the path from the first location to one of the locations toward the second location (see at least 4:1-28), the player is provided any award associated with the location of the symbol (see at least 4:1-28), the symbol is relocated to one of the locations along the path toward the first location and further from the second location if the symbol moves to the location associated with the setback condition (see at least 4:16-19), and the symbol is moved to another one of the locations toward the second location and further from the first location wherein the movement of the symbol terminates if the symbol is moved to one of the locations that is not between the first location and the second location (see at least 1:65-2:14 and 4:29-58).

### *Claim Rejections - 35 USC § 103*

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 53-54, 57-58, 61-62, 65-66, and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss in view of Official Notice.

Weiss teaches the invention substantially as described above, but lacks in disclosing operating a game method through a data network including the Internet. The Examiner takes Official Notice that it was notoriously well known to those of ordinary skill in the art to operate gaming machines through a data network including the Internet in order to control gaming devices from a remote location. Therefore, the above-mentioned claims are obvious in view of the teachings of the prior art.

### *Citation of Pertinent Prior Art*

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is contained in the attached Notice of References Cited.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch Jr. whose telephone number is 571-272-2818. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William H. McCulloch Jr.
Examiner
Art Unit 3714
9/13/2007

wm

Robert E. Pezzuto
Supervisory Patent Examiner
Art Unit 3714